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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/861,231 05/21/97 ILVESPA

H 1781-73

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GM01/0720

EXAMINER

WILSON, P

ART UNIT

PAPER NUMBER

3744

12

DATE MAILED:

07/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/861,231**

Applicant(s)  
**Hvespaa**

Examiner  
**Pamela A. Wilson**

Group Art Unit  
**3744**



☒ Responsive to communication(s) filed on May 11, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-26, 28-34, and 36-41 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-25 is/are allowed.

☒ Claim(s) 26, 28-34, and 36-41 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **FINAL ACTION**

Applicant's amendment filed 5/11/99 has been received and entered accordingly.

#### ***Recapture Rejection***

Claims 26, 28-34 and 36-41 are rejected under 35 U.S.C. 351 as being an improper recapture of claimed subject matter which broadens the scope of the claims of the original patent upon which the present reissue is based. As stated in *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997).

Claims 26, 28-34 and 36-41 do not contain specific claim limitations which were amended into the claim language, of the original patent, in an effort to define the applicant's invention over the prior art; and thus, the lack of this amended claim language is considered to violate the doctrine of recapture. The following claim language, from the original patent, is believed to be absent from the newly submitted claims of the present reissue:

The application of a steam treatment to an open face of a paper web, during the run of the web through the drying section of the paper machine; wherein, the web has opposed top and bottom sides and by pressing the bottom side of the web against the drying cylinders as the web runs on a wire (or a free draw), after the bottom side of the web separates from the heated face of the drying cylinders, the temperature of the bottom side of the web is raised by applying a sufficient amount of steam onto the bottom side of the

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web for the purpose of controlling the moisture gradient in the thickness direction of the paper web between the paper sides.

***Allowable Subject Matter***

Claims 1-25 are allowed.

***Remarks***

In regards to the examiner's rejection of claims 26, 28-34 and 36-41 under 35 U.S.C. 112, 1st paragraph, which was concerned with whether or not the original specification properly supported the limitation of applying steam onto the entire width of a paperweb in the drying section of a paper machine has been rescinded.

Additionally, the examiner's rejection of claims 26, 28-34 and 36-41 under 35 U.S.C. 351, as being an improper recapture of claimed subject matter which broadens the scope of the claims of the original patent, upon which this reissue application is based, is maintained by the examiner to be proper.

In response to the applicant's arguments which contend that In re Clement is not applicable to the claims here in issue and that the more recent findings of Hester Industries, Inc. v. Stein, Inc., 46 USPQ 2d 1641 (Fed. Cir. 1998) are more relevant to the facts of the application, the examiner respectfully disagrees.

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The applicant has broadened the patent claims in a manner directly pertinent to the subject matter that applicant surrendered during prosecution; and under Clement, that is precluded by the equitable recapture doctrine.

Hence, the claim limitations of the original patent, which are absent from the aforementioned claims and which were amended into the original claim language to overcome the prior art, are in violation of the recapture doctrine as defined by In re Clement. Furthermore, applicant has not distinguished this situation from the facts of In re Clement; and therefore the examiner's rejection is retained and made final.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Wilson whose telephone number is: 703/308-2620. Information may also be sent to the attention of the examiner via facsimile machine at: 703/308-7764.

Pamela Wilson: paw

June 28, 1999



**HENRY A. BENNETT**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3700**